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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,536	06/29/2000	Earl A. Hubbell	AFFYP007X1C1	1335

26541 7590 06/25/2003
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EXAMINER
FREDMAN, JEFFREY NORMAN

ART UNIT	PAPER NUMBER
1634	

DATE MAILED: 06/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/607,536

Applicant(s)

HUBBELL ET AL.

Examiner

Jeffrey Fredman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on April 28, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-10 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-10 and 24-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The newly filed substitute specification is acceptable.

Claim Rejections - 35 USC § 112

The rejection of claims 8-10 and 24-26 under 35 U.S.C. 112, second paragraph, is withdrawn in view of the argument.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The rejection of claims 8-10 and 24-26 as being anticipated by Socransky et al is withdrawn in view of the argument.
4. Claims 8-10 and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Chee et al (U.S. Patent 5,837,832).

Chee teaches a substrate (column 6, lines 14-34, with nucleic acid probes coupled onto the membrane (see column 14, lines 14-34 and figure 26, for example) comprising:

a) a plurality of regions on the substrate in which diverse polymer probes are coupled in a checkerboard pattern, such as every overlapping 17 mer probe from exon 5 of the p53 tumor suppressor gene as well as four additional probes with each possible

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substitution at base 7 were also placed on the array (see figure 26 and column 23, lines 13-28) and,

b) a plurality of regions on the substrate in which the polymer probes having the same sequence are coupled and the array also clearly has many regions in which polymer probes having the same sequence are coupled, but where there are clearly sequences on the array that could bind to the same control monomer sequence but which are different in their actual sequence (see figure 26 and column 23, lines 13-28). For example, as shown in column 26, lines 45-50, when overlapping probes are made, they share all of their sequence but one nucleotide. Thus, the probes of Chee have probes which can bind to the same 16 mer target probe, since they share that entire region, but which differ in actual sequence. Further, as noted in column 23, Chee expressly also places additional probes with each possible substitution. For each probe, one of these four probes will be identical to the wildtype, yielding a situation where two identical probes are paired. Figure 27 makes this perfectly clear. In the first row, where there is a T at the first position, the WT probe and the bottom probe would be identical, since both would have a T. There would be three different probes, which share 16/17 nucleotides, differing at position 7 with either an A, C, or G instead of a T. These would have been made with different monomer addition cycles and in any case, the products are not different however they are made.

Response to Arguments

1. Applicant's arguments filed April 28, 2003 have been fully considered but they are not persuasive.

Applicant argues that Chee does not teach formation using a different monomer cycle. This argument is not persuasive because it reads method limitations into the product claim. All the base independent product claim requires is multiple sequences on a support where some are the same and some differ by a single monomer. How these monomer sequences are formed upon the support is not relevant to this product claim. As MPEP 2113 notes "If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." So in the current case, even if Chee makes the product using a different process, the resultant product is the same. Therefore, Chee properly anticipates the claimed invention and the Chee rejection will be maintained.

Conclusion

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Fredman whose telephone number is 703-308-6568. The examiner can normally be reached on 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 703-308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Jeffrey Fredman
Primary Examiner
Art Unit 1634

June 17, 2003